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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,886	04/18/2001	Stephen L. Mayo	A-65353-8/RFT/RMS/RMK	2783
7590	01/09/2004			EXAMINER KIM, YOUNG J
ROBIN M. SILVA, ESQ. FLEHR HOHBACH TEST ALBRITTON & HERBERT LLP Suite 3400 Four Embarcadero Center San Francisco, CA 94111-4187			ART UNIT 1637	PAPER NUMBER

DATE MAILED: 01/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/837,886	MAYO ET AL.	
	Examiner	Art Unit	
	Young J. Kim	1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 November 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 28,29 and 53-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 28,29,53,54,63-66,69,73 and 77-80 is/are allowed.
- 6) Claim(s) 67,68,71,72,75 and 76 is/are rejected.
- 7) Claim(s) 55-62,70 and 74 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____.
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) Other: _____

DETAILED ACTION

This Office Action responds the Amendment received on November 3, 2003.

Claim Objections

The objection of claims 30-48 for depending on a subsequent claim, made in the Office Action mailed on February 10, 2002 is withdrawn in view of the Amendment received on November 3, 2003, canceling the objected claims.

The objection of claim 32 for being improperly multiple dependent, made in the Office Action mailed on February 10, 2002 is withdrawn in view of the Amendment received on November 3, 2003, canceling the objected claim.

The objection of claims 32, 40, and 43 for failing to comply with claim arrangements as defined in MPEP 608.01(n), made in the Office Action mailed on February 10, 2003 is withdrawn in view of the Amendment received on November 3, 2003, canceling the objected claims.

Objections – Necessitated by Amendment

Claims 55-62, and 70 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 55-62 and 70 have not been further treated on the merits.

Claim 74 is objected to because it appears to contain a grammatical error. For example, the phrase, “wherein step (c) *comprises a second group for a second variable position has a second set of at least two amino acid side chains*,” does not make grammatical sense. It appears

that the phrase should read, "wherein step (c) comprises a second group for a second variable position which has a second set of at least two amino acid side chains."

Appropriate correction are required.

Claim Rejections - 35 USC § 112

The rejection of claims 45-48 under 35 U.S.C. 112, second paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the invention was filed, had possession of the claimed invention, made in the Office Action mailed on February 10, 2003 is withdrawn in view of the Amendment received on November 3, 2003, canceling the rejected claims.

Rejections – Necessitated by Amendment

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 67, 68, 71, 72, 75 and 76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 67 and its dependent claim 68 recite the limitation "said list." There is insufficient antecedent basis for this limitation in the claim.

Claim 71 is dependent on itself, rendering the claim indefinite in its metes and bounds and failing to have proper antecedent basis. Claim 72 is dependent on claim 71, also rendering the claim indefinite in its metes and bounds and failing to have proper antecedent basis.

Claim 76 is dependent on itself, rendering the claim indefinite in its metes and bounds and failing to have proper antecedent basis. Claim 75 depends on claim 76, rendering the claim indefinite in its metes and bounds and failing to have proper antecedent basis.

Double Patenting

The rejection of claims 28, 29, 33, 38, and 45-48 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 6, 11, and 18-21 of U.S. Patent No. 6,269,312, made in the Office Action mailed on February 10, 2003 is withdrawn in view of the Terminal Disclaimer filed on August 13, 2003 and the Amendment received on November 3, 2003.

The rejection of claims 30, 31, 34-37, 39-44, 51, and 52 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 7-10, 12-17 of U.S. Patent No. 6,269,312 B1, made in the Office Action mailed on February 10, 2003 is withdrawn in view of the Terminal Disclaimer filed on August 13, 2003 and the Amendment received on November 3, 2003.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Young J. Kim whose telephone number is (703) 308-9348 (**effective January 14, 2004, changed to 571-272-0785**). The Examiner can normally be reached from 8:30 a.m. to 6:00 p.m. Monday through Thursday. If attempts to reach the Examiner by telephone are unsuccessful, the Primary Examiner in charge of the prosecution, Dr. Kenneth Horlick, can be reached at (703)-308-3905 (**effective January 14, 2004, changed to 571-272-0784**). If the attempts to reach the above Examiners are unsuccessful, the Examiner's supervisor, Gary Benzion, can be reached at (703) 308-1119. Papers related to this application may be submitted to Art Unit 1637 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant does submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office. All official documents must be sent to the Official Tech Center Fax number: (703) 872-9306. For Unofficial documents, faxes can be sent directly to the Examiner at (703) 746-3172 (**effective January 14, 2004, changed to 571-273-0785**). Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

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Young J. Kim

12/30/03



KENNETH R. HORLICK, PH.D.
PRIMARY EXAMINER

1/6/04